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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,144	12/21/2000	Wayne E. Cornish	ACS58266(15951)	2421

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,144

Applicant(s)

CORNISH ET AL.

Examiner

Charles A. Marmor, II

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Reply to Office Action filed June 6, 2005. The Examiner notes that no amendments have been made. Claims 1-5, 7 and 10 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Muni et al. ('629). Muni et al. teach an elongated device for medical procedures having a superelastic member (26) with proximal and distal ends and an elongated proximal member (12) having proximal and distal ends, where the proximal end of the superelastic member is secured to the distal end of the proximal member. A first, proximal section of the superelastic member has a first set of properties (see column 5, lines 57-64) and an adjacent second, distal section has a second set of properties (reduced superelasticity) that are altered from the first set of properties (see column 6, lines 23-26).

4. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams et al. ('818). Abrams et al. teach an elongated device for medical procedures having a superelastic member (12) with proximal and distal ends and an elongated proximal member (11) having proximal and distal ends, where the proximal end of the superelastic member is secured to the distal end of the proximal member. A second, proximal section of the superelastic member that is to be soldered is treated to give the proximal section a set of properties that are different from the set of properties exhibited by an adjacent first, distal section of the superelastic member (see column 9, lines 18-55).

Allowable Subject Matter

5. Claims 7 and 10 are allowed over the prior art of record.

Response to Arguments

6. Applicant's arguments filed June 6, 2005 have been fully considered but they are not fully persuasive. Applicant contends that Abrams et al. do not teach every element of the claims. Specifically, Applicant argues that Abrams et al. fail to disclose a superelastic member having a first section with a first set of properties and an adjacent second section having a second set of properties which have been altered from the first set of properties. The Examiner respectfully disagrees. Column 9, lines 18-55 of the Abrams et al. patent disclose that a proximal (second) section of the superelastic member, that is to be soldered, is treated to give the proximal section a set of properties that are different from a set of properties exhibited by an adjacent distal (first) section of the superelastic member. However, the Examiner does concede that Abrams et al. fail

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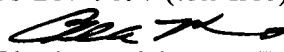
to teach the limitations of claims 3 and 4. Therefore, the rejection of claims 3 and 4 under 35 U.S.C. 102(b) as being anticipated by Abrams et al. has been withdrawn. A new rejection of claims 1-5 under 35 U.S.C. 102(e) as being anticipated by Muni et al. is set forth hereinabove.

The Examiner acknowledges that the only IDS filed in the instant application has already been considered. The statement regarding the IDS set forth in the Office Action of January 6, 2005 has been withdrawn.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles A. Marmor, II
Primary Examiner
Art Unit 3736

cam
August 19, 2005